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In re Application of
Alfred Binggeli et al
Serial No.: 08/711,339
Filed: September 6, 1996
Attorney Docket No.: 4019/135

PETITION DECISION

#222
Decision Date
11/6/00
Robert # 21

This is in response to applicants' renewed petition under 37 CFR 1.144, filed April 2, 1999 (Certificate of Mailing date), requesting withdrawal of an improper restriction requirement.

FILE HISTORY

The file history is set forth in the previous decision mailed February 3, 1999. Subsequent to the mailing of the decision applicants filed one copy of an Appeal Brief and required fee on February 22, 1999, and this renewed petition on April 2, 1999.

DISCUSSION

M.P.E.P. 803.02, quoted in the previous decision, is again reproduced as it gives guidance as to Office practice in applications containing Markush type claims, which claim 1 appears to be.

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction.

Since the decisions in *In re Weber*, 198 USPQ 328 (CCPA 1978); and *In re Haas*, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); *Ex Parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.

This subsection deals with Markush - type generic claims which include a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. A Markush - type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush - type

claim should be found not allowable. Following election, the Markush - type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If Markush - type claim is not allowable over the prior art, examination will be limited to the Markush - type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

As an example, in the case of an application with a Markush - type claim drawn to the compound C - R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush - type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush - type claim and claims to the elected species shall be rejected, and claims to the non - elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the rejected claims would be made final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush - type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush - type claim with respect to a non - elected species, the Markush - type claim shall be rejected and claims to the non - elected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all non - elected species. Should applicant, in response to this rejection of the Markush - type claim, overcome the rejection, as by amending the Markush - type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush - type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush - type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush - type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

As stated in the previous decision, the examiner acted properly according to M.P.E.P. 803.02 in examining the application in that an election of a single disclosed species was required on first action. The elected species was then examined and found patentable and the search extended to a reasonable number of additional related species which the examiner determined to form a genus of compounds which are patentable over the prior art. The genus described by the examiner in the Office action mailed September 25, 1998, sets forth a group of claimed compounds which meet the criteria of M.P.E.P. 803.02 as previously noted in that they all share (1) a common utility and (2) a substantial structural feature essential to that utility.

Applicants argued in the first petition and repeat the argument in this petition that the examiner is without authority to create a generic concept and to thus limit the claims. Applicants also assert that the examiner has not made a search of all claims readable on the elected species including claims 1. Applicant further argues that the search has not been extended with regard to the Markush-type claim. Applicants also state that the root question is whether the Office has the authority to create a "generic concept" inclusive of the species elected by the applicant and require the applicant to amend the claim so as to encompass only that generic concept. Applicant argues in conjunction therewith that the Office has made the type of rejection expressly forbidden by *In re Weber* and *In re Haas*. Applicants' concern regarding inventorship issues is not within the purview of the Office, other than to the extent that applicants are required to ensure that the inventorship is correct for the claims eventually allowed in an application. How that is determined is within applicants' purview. Applicants further argue that the Office position with regard to *In re Weber* is contrary to the law.

As stated in the first petition decision the Office has and always has had the ability to limit the claims in an application to a single invention as provided under the authority of 35 U.S.C. 121. There is nothing which prohibits the Office from determining a generic concept based on a single elected species and requiring the claims be limited to the generic concept when the generic concept expressed by an applicant is so broad and diverse that numerous generic concepts are included within a single claim. As a single example of diverse generic concepts encompassed within claim 1, variable Q is exemplary. Q is defined as an ethylene bridge which when present connects the 2 and 6 positions of a piperidine ring. In doing so Q creates a basic three dimensional structure generally called a cage structure which has little or no flexibility. In contrast, when Q is absent the base structure is a six membered ring containing one nitrogen (piperidine ring) which can exist in either cis or trans configuration and flex between them. There is no doubt that these two vastly different structures are different inventions based on classification, structure, reactivity and other factors. Yet they are claimed in the same claim. Applicants' argument is that a claim cannot be directed to more than one invention, yet applicants' claim 1 herein is directed to at least two vastly different compounds which must be considered to be separate and patentably distinct inventions since they have no common structure. It is for this reason that the examiner, based on the elected species, created what is considered to be a reasonable generic class of compounds for examination purposes. As previously stated, applicants gave no written guidance to the examiner as to what applicants considered a proper generic concept to be which included the elected species, but depended solely on the discretion of the examiner.

Applicants' argument that the search of the elected species and subsequent generic concept developed by the examiner has not been extended to claim 1 is incorrect. The examiner has extended the examination of the elected invention to claim 1, but found additional inventions set forth therein. That portion of claim 1 reading on the generic concept developed by the examiner has been allowed and the other parts of the claim left unexamined and subject to restriction. The examiner has made no rejection of the claim, but has made a requirement that the claim be limited to the elected genus. Applicant argues that such is expressly forbidden by *In re Haas* and *In re Weber*. Applicants are incorrect in their statement. *In re Weber* and *In re Haas* prohibit the making of a rejection under 35 U.S.C. 121. The examiner has made no such rejection, only a requirement that the claims be limited to the generic concept searched. Applicants argue that what the examiner has done is in effect a rejection. This is incorrect. What the examiner has done is set forth an administrative requirement and invited applicants compliance.


Applicants also comment that it is unclear whether the second group encompassing all compounds other than those in the first group, the genus searched by the examiner, contains one or many alleged inventions. Certainly if applicants cannot make such a determination with reasonableness, an examiner should not be required to do so. Obviously the examiner considered claim 1 as written and determined that there were multiple inventions included thereunder and invited applicants to elect a species upon which a genus would be based should the elected species be found allowable. From the wide range of variables in claim 1 it is impossible to determine what applicants preferred invention is as it is hidden among more than 11 quadrillion compounds. Having determined one genus thereunder, it is not required of the examiner to determine each and every possible genus in addition to the one determined to be patentable based on the elected species.

DECISION

Applicants' petition to withdraw the restriction requirement as improper is **DENIED** for the reasons stated above..

Any request for reconsideration of this decision or a renewed petition must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely. Extensions of time may be available under 37 CFR 1.136(a).

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600/2900, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 308-7922.



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